



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

09/869,566

02/19/2002

Audrey Goddard

P 2534-3

4737

9157 7590 01/24/2008
GENENTECH, INC.
1 DNA WAY
SOUTH SAN FRANCISCO, CA 94080

EXAMINER

JIANG, DONG

ART UNIT

PAPER NUMBER

1646

MAIL DATE

DELIVERY MODE

01/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/869,566 | GODDARD ET AL. | |
| | Examiner | Art Unit | |
| | Dong Jiang | 1646 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20,22,26-28 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31 is/are allowed.
- 6) ☒ Claim(s) 20,22,26-28 and 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>2/14/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED OFFICE ACTION

The request filed on 31 October 2007 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/869,566 is acceptable, and a RCE has been established. An action on the RCE follows.

Applicant's amendment filed on 31 October 2007 is acknowledged and entered. Following the amendment, claim 26 is amended.

Currently, claims 20, 22, 26-28 and 31-36 are pending and under consideration.

Rejections Over Prior Art:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20, 22, 26-28 and 32-36 remain rejected under 35 U.S.C. 102(e) as being anticipated by Sims et al., US2003/0091532 A1 (now US patent No. 7,033,783), for the reasons of record set forth in the previous Office Actions mailed on 9/27/04, 6/14/05, 1/11/06 and 1/30/07.

Applicants argument filed on 31 October 2007 has been fully considered, but is not deemed persuasive for reasons below.

At page 5 of the response, the applicant argues that the provisional application 60/112,163, the document upon which Sims et al. relies for priority, does not disclose the claimed SEQ ID NO:5, as such, the Sims reference cannot be prior art to the disclosed invention. This argument is not persuasive because although Sims' 60/112,163 application does not disclose the claimed SEQ ID NO:5, it does disclose the same SEQ ID NO:3 as that in Sims'

Application/Control Number:
09/869,566
Art Unit: 1646

Page 3

US2003/0091532 A1 (see Figure 3 in 60/112,163), which is cited/applied in the instant rejection. Therefore, the effective filing date of the prior art reference US2003/0091532 A1 is 12/14/98, the actual filing date of 60/112,163, which predates the filing date of applicants earliest provisional application 60/113,430 (12/23/98).

Conclusion:

Claim 31 is allowable.

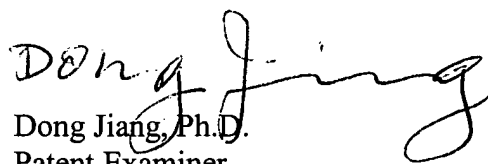
Application/Control Number:
09/869,566
Art Unit: 1646

Page 4

Advisory Information:

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

A handwritten signature in cursive script that reads "Dong Jiang".

Dong Jiang, Ph.D.
Patent Examiner
AU1646
1/18/08